

Appl. No. 10/664,231
Amdt. September 7, 2004
Reply to Office action of March 31, 2004

REMARKS/ARGUMENTS

This amendment is in response to the office action mailed March 31, 2004. A petition for a three-month extension of time, as well as the appropriate fee, is submitted herewith.

The Examiner objected to claim 7. Claim 7 has been amended to correct the informalities and Applicant requests that the objection be withdrawn.

Applicant notes that claims 15 and 16 were objected to as being dependent upon a rejected base claim. Applicant submits new claims 41 and 42, which correspond to claims 15 and 16, respectively, rewritten in independent form. Hence claims 41 and 42 are allowable.

The Examiner rejected claims 1-13 and 17 under 35 U.S.C. §103 as being unpatentable over Williams et al in view of Soens. Applicant respectfully traverses the rejections. The references do not establish *prima facie* obviousness. To establish *prima facie* obviousness all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974), as cited in *The Manual of Patent Examining Procedures* §2143.03 (2001 ed). Independent claim 1 calls for a conductive filler material within the electrically insulating material in a quantity sufficient for the disc to maintain an electrostatic charge. This limitation is not taught or suggested by either reference alone or in combination.

Williams clearly does not teach or suggest the limitation and, in fact, teaches away from the invention. Williams discloses and claims an electrically insulating material that functions as

a physical barrier. Soens, on the other hand, does not teach or suggest a wildlife guard and does not teach or suggest using his product in a wildlife guard. There is no motivation to combine Williams and Soens. Soens is non-analogous art. Analogous art is art that is either in the field of technology of the claimed invention or deals with the same problem solved by the claimed invention even though outside the field of technology of the invention. *In re Wood*, 599 F.2d 1032 (CCPA 1979).

"Section 103 requires us to presume full knowledge by the inventor of the prior art in the field of his endeavor" ... but it does not require us to presume full knowledge by the inventor of prior art outside the field of his endeavor, i.e., of "nonanalogous" art. In that respect it only requires us to presume that the inventor would have had that ability to select and utilize knowledge from other arts reasonably pertinent to his particular problem which would be expected of a man of ordinary skill in the art to which the subject matter pertains.

In re Antle, 444 F.2d 1382, 1387 (CCPA 1971), quoting *In re Winslow*, 365 F.2d 1017, 1020 (CCPA 1966).

In *In re Horn*, 203 USPQ 969 (CCPA 1979), the Court considered a method of producing a fast food version of corn-on-the-cob. Because the fat fryers either overcooked the kernels or undercooked the cob, this method of fast cooking corn-on-the-cob was unsatisfactory. Applicants solved the problem by boring an axial hole in the cob. This permitted the deep fat fryer to thoroughly cook the cob without overcooking the kernels. The cited prior art disclosed a method of preserving corn by boring a hole in the cob to promote drying and prevent molding. The court held that

while the ***scientific principle involved*** in boring the hole in the cob was the same (creating a heat exchange surface inside the cob), one of ordinary skill in the art would not have been expected to look at a corn preserving patent to obtain guidance as to how to solve the problem of cooking frozen corn-on-the-cob in the fast food restaurant.

The Court stated that:

For the teachings of a reference to be prior art under Section 103, there must be some basis for concluding that the reference would have been considered by one skilled in the particular art working on the pertinent problem to which the invention pertains.

Id. at 971.

The instant invention relates to devices used to protect electrical distribution and substation equipment from invasion by a small animal. One skilled would not look to a product for shielding electromagnetic radiation when looking to solve the problem of keeping animals out of electrical equipment.

Moreover, Soens does not maintain an electric charge. Soens' product is designed to be used as a shield against radio frequency and high-frequency electromagnetic radiation or as antistatic plastic articles. Hence, Soens teaches the use of a product that is conductive and sheds electromagnetic radiation rather than maintaining an electric charge, as provided by the instant invention. The maintenance of an electrostatic charge would render Soens' invention inoperable. Hence, in addition to being non-analogous art, Soens teaches away from an animal guard formed from conductive material that maintains an electrostatic charge.

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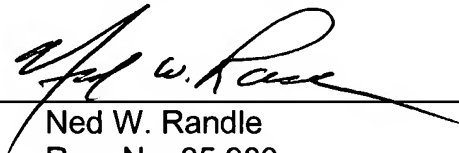
Applicant again respectfully points out that *The Manual of Patent Examining Procedure* at § 2143.03 states, "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988)." Because independent claim 1 is allowable over the art of record, Applicant submits that under the relevant law, the dependent claims also are allowable.

Based upon the foregoing, it is clear that the claims are allowable over the prior art. Applicant respectfully requests the Examiner to withdraw the rejections, allow the claims, and pass the case to issue.

Respectfully submitted,

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